UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/943,863	08/31/2001	Carl H. Staelin	10019510-1	2228

7590   04/22/2005

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EXAMINER
NGUYEN, NHON D

ART UNIT	PAPER NUMBER
2179	

DATE MAILED: 04/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Office Action Summary	Application No.	Applicant(s)
		09/943,863	STAELIN ET AL.
		Examiner	Art Unit
		Nhon (Gary) D Nguyen	2179

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE **3** MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 December 2004*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,4,7-9,12,14 and 18-24* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4,7-9,12,14 and 18-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *31 August 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____ .

DETAILED ACTION

1. This communication is responsive to amendment, filed 12/30/2004.

2. Claims 1, 4, 7-9, 12, 14 and 18-24 are pending in this application. Claims 1, 9, 12 and 24

are independent claims. In this amendment, no claim is canceled, no claim is amended, and no

claim is added. This action is made non-final.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
> in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
> patent by another filed in the United States before the invention by the applicant for patent, except that an
> international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this
> subsection of an application filed in the United States only if the international application designated the United
> States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 4, 7-9, 12, 14 and 18-24 rejected under 35 U.S.C. 102(e) as being anticipated

by Morcos et al. ("Morcos", US 6,384,849).

As per claim 1, Morcos teaches a computer implemented method and corresponding

system for providing a menu in relation to a document comprising the steps/means:

creating a document within a program; (creating a word document, with a embedded

behavior spreadsheet object, within the MS Word program; col. 13, lines 25-34);

creating a predetermined behavior that can be used to modify documents opened within

the program but that is not generally available for selection from a main menu of the program

(e.g. Excel server program 1105 of fig. 11 defines a predetermined behavior, for Excel documents, that is not available from the main Word menu 1100);

specifically associating the predetermined behavior with the created document (the merged menu items in Morce's system are clearly the predetermined behaviors associated with a spreadsheet object of the created word document; col. 13, lines 27-34; e.g. any Excel document is associated with the predetermined behavior 1105 of fig. 11); and

creating a menu item associated with the predetermined behavior that is configured for addition to the main menu when the defined document is opened within the program but that is not made generally available for all documents opened within the program, such that the predetermined behavior will be available for selection from the main menu for the defined document but not necessarily for other documents opened within the program (col. 13, lines 25-34 and 1110 of fig. 11; col. 15, lines 25-57).

As per claim 4, which is dependent on claim 1, Morcos teaches the method further comprising merging the menu item associated with the predetermined behavior with the main menu of the program when the created document is opened within the program such that the menu item associated with the predetermined behavior is presented to the user for selection in specific association with the created document (col. 13, lines 25-34 and 1110 of fig. 11; col. 15, lines 23-57).

As per claim 7, which is dependent on claim 1, Morcos teaches specifically associating the predetermine behavior with the created document comprises creating a list of behaviors associated with the created document (fig. 8; col. 12, line 60 – col. 13, line 22).

As per claim 8, which is dependent on claim 7, Morcos further teaches defining a pointer associated with the created document, the pointer pointing to the list of behaviors (col. 9, lines 9-25).

As per independent claim 9, it is a similar scope to claim 1; therefore, it should be rejected under the same rationale.

As per independent claim 12, Morcos teaches a computer implemented method and corresponding system for providing a menu in relation to a particular document that was created and is running in a program comprising the steps/means:

receiving a user input (col. 9, lines 53-55);

generating a command message in response to the user input, the command message comprising a command ID indicative of a predetermined process that corresponds to a selected menu item (col. 9, lines 9-35 and lines 47-67);

determining if the command ID corresponds to a predetermined behavior that has been specifically associated with the particular document; and initiating a process represented by the predetermined behavior where it is determined that the command ID corresponds to the

predetermined behavior that has been specifically associated with the particular document (col. 9, lines 9-35 and lines 47-67).

As per claim 14, which is dependent on claim 12, Morcos teaches the user input comprises selection of a displayed menu item (col. 9, lines 53-55).

As per claim 18, which is dependent on claim 4, Morcos teaches merging the menu item comprises adding a new menu to the main menu, the merged menu item being contained within the new menu (col. 13, lines 25-34 and 1110 of fig. 11; col. 15, lines 23-37).

As per claim 19, which is dependent on claim 4, Morcos teaches merging the menu item comprises adding the menu item to an existing menu of the main menu (col. 13, lines 25-34 and 1110 of fig. 11; col. 15, lines 23-37).

As per claim 20, which is dependent on claim 7, Morcos teaches creating a list of behaviors comprises creating a list of behaviors that includes the predetermined behavior (fig. 8; col. 12, line 60 – col. 13, line 22).

As per claim 21, which is dependent on claim 9, Morcos teaches the login configured to create a main menu is configured to create a main menu comprising menu items that are associated with behaviors that are generally available for all document opened within the program (Word container program 1100 of fig. 11 is a main menu including menu items that are

associated with behaviors that are generally available for all Word documents opened within the program).

As per claim 22, which is dependent on claim 9, it is rejected under the same rationale as claim 7.

As per claim 23, which is dependent on claim 22, it is rejected under the same rationale as claim 8.

As per independent claim 24, it is a similar scope to claim 12; therefore, it should be rejected under the same rationale.

Response to Arguments

5. Applicant's arguments filed 12/30/2004 have been fully considered but they are not persuasive.

Applicant argued the following:

(a) Referring to claims 1 and 9, Morcos fails to teach or suggest creating a menu item for addition to main menu of a given program when a document that was created in that same program is opened within the program. In other words, Morcos, at best, discloses adding a menu item when documents from a different program are imported.

(b) Referring to claim 1, Morcos does not disclose that the merged menu items are added to the main menu "when the created document is opened within the program". To the contrary, Morcos only describes such merger when a document is embedded into another.

(c) Referring to claim 1, Morce says nothing about "specifically associating the predetermined behavior with the created document.

(d) Referring to claims 12 and 24, Morcos fails to teach or suggest "initiating a process represented by the predetermined behavior where it is determined that the command ID corresponds to the predetermined behavior that has been specifically associated with the particular document.

(e) Referring to claims 12, Morcos does not teach or suggest performing the various recited actions in relation to a document that was "created with and is running in a program".

Examiner disagrees for the following reasons:

(a) The claim language only shows "creating a menu item associated with the predetermined behavior that is configured for addition to the main menu of the program when the created document is opened within the program". The Morcos reference clearly reads on that limitation of the claim language. A MS Excel embedded document, within a MS Word program, does create menu items associated with the predetermined behavior (e.g. menu items 1105 fig. 11) that is configured for addition to the main menu of the program (adding the MS Excel predetermined behavior menu items 1105 into the main menu of the MS Word container 1100 to form a new combined 1110 main menu of fig. 11) when the created MS Excel document is activated and edited from within the MS Word program (col. 13, lines 27-34).

(b) Since a spreadsheet may be embedded in a word processing document (col. 13, lines 25-27), when a spreadsheet object is opened (by being activated and edited) from the word processing document, the merged menu items from spreadsheet are added to the main menu of the word processing (col. 13, lines 25-57). Therefore, the Morcos reference does read on the language of claim 1.

(c) The merged menu items in Morce's system are clearly the predetermined behaviors associated with a spreadsheet object of the created word document (col. 13, lines 27-34).

(d) The merged menu items in Morce's system are clearly the predetermined behaviors associated with a spreadsheet object of the created word document (col. 13, lines 27-34 and col. 9, lines 9-35 and lines 47-67).

(e) The created word document, with embedded behavior spreadsheet, is created and is running in MS Word program (col. 13, lines 25-57).

Inquiries

6.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nhon (Gary) D Nguyen whose telephone number is (571)272-4139. The examiner can normally be reached on Monday - Friday with every other Monday off.
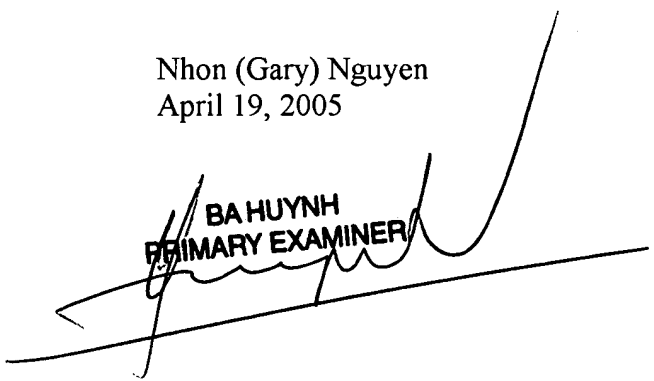
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on (571)272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nhon (Gary) Nguyen
April 19, 2005

BA HUYNH
PRIMARY EXAMINER